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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/735,721

12/13/2000

Louis Brown Abrams

D. N. 7218

4531

7590

11/15/2006

Sheridan Ross PC

1560 Broadway

Suite 1200

Denver, CO 80202-5141

EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/735,721

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,16-38,40-45 and 48-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,16-18,25-31,40-42,44,48-50 and 53-57 is/are allowed.
- 6) ☒ Claim(s) 43,45,51 and 52 is/are rejected.
- 7) ☒ Claim(s) 19-24 and 32-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05/06, 8/18/06, 8/22/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed May 31, 2006, has been entered.

Response to Amendment

2. Applicant's compliant amendment filed on September 5, 2006, has been entered. The specification and claims 1, 25, 26, 43, 44, and 53 have been amended as requested. Claims 3-15, 39, 46, and 47 have been cancelled, while new claims 55-57 have been added. Thus, the pending claims are 1, 2, 16-38, 40-45, and 48-57.

3. Said amendment is sufficient to withdraw the objection to claim 25 as set forth in section 5 of the last Office Action. Additionally, the objection to claim 41 as set forth in section 6 of the last Office Action is hereby withdrawn per applicant's arguments in the amendment, page 11, 1st paragraph. Furthermore, the 112, 2nd rejections set forth in sections 11 and 12 of the last Office Action are hereby withdrawn due to said amendment.

4. The prior art rejection of claims 1, 2, 16-18, 25-31, 38, 40-45, 48-50, 53, and 54 as set forth in sections 14-16 of the last Office Action are hereby withdrawn. See discussion set forth below of the claims with respect to the cited prior art.

Specification

5. The objection to the specification set forth in section 3 of the last Office Action is hereby maintained. Applicant has amended the specification to state “a fringe material can be applied to opposed peripheral edges of the flocked release sheet 1 or substrate 15 during this manufacturing process.” Applicant argues, “Fig. 3 clearly illustrates the flocked release sheet as having a fringe material at opposed peripheral edges.” (Amendment, page 10, 2nd paragraph). While it is true that Figure 3 show a fringe material at two opposing edges (i.e., short edges) of the flocked release sheet, said Figure does not provide support for fringe at the other two opposing edges (i.e., long edges), which is included in the scope of amended specification. Additionally, said Figure still does not provide support for the fringe material on the edges of the substrate 15. Hence, the new matter objection to the specification is maintained.

Claim Objections

6. The objection to claim 38 as set forth in section 5 of the last Office Action is hereby maintained. Applicant traverses the objection by arguing that claim 38 describes the structure of the thermoplastic sheet before contact with the flock, while claim 26 from which 38 depends, merely describes the thermoplastic sheet generally when in contact with the flock (Amendment, paragraph spanning pages 10-11). The examiner fails to see any difference since the “pre-formed” limitation of claim 26 is interpreted as being descriptive of the thermoplastic sheet before application of said sheet to the flock. Thus, the objection is hereby maintained.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 43 and 45 stand rejected under 35 USC 112, 1st paragraph, as failing to comply with the written description requirement, as set forth in section 8 of the last Office Action. As discussed above, the specification as originally filed does not provide adequate support for the fringe material on the two long opposing edges of the release sheet.

9. Claims 51 and 52 stand rejected under 35 USC 112, 1st paragraph, as failing to comply with the written description requirement, as set forth in section 9 of the last Office Action.

Despite applicant's amendment attempting to overcome said rejection, the rejection stands because the specification does not provide support for the negative recitation that "substantially none of the thermoplastic hot melt sheet fails to contact the free ends of the flock." MPEP 2173.05(i), *Negative Limitations*, states "Any negative limitation or exclusionary proviso must have basis in the original disclosure." See *Ex parte Grasselli*, 231 USPQ 393. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Allowable Subject Matter

10. Claims 19-24 and 32-37 stand objected to as set forth in section 17 of the last Office Action.

11. Claims 1, 2, 16-18, 25-31, 38, 40-42, 44, 48-50, and 53-57 contain allowable subject matter since the prior art rejection set forth in sections 14-16 of the last Office Action.

Specifically, applicant's argument that the combination of Higashiguchi and Abrams would change the principle of operation of Higashiguchi (Amendment, section 3, pages 16-17) has been found persuasive. Note one of Higashiguchi's objectives is to "provide a method of transferring a flock pattern of flock fibers to one surface of a material without employing a conventional patterned flock transferring material" (col. 3, lines 5-8). By "conventional patterned flock transferring material," Higashiguchi is referring to a flocked transfer having a pattern of adhesive formed thereon (col. 1, lines 11-46), rather than the Higashiguchi reference which forms the pattern of adhesive on the substrate to be flocked. Thus, modification of Higashiguchi with the teachings of Abrams would change the principle of operation intended by Higashiguchi as well as render Higashiguchi unsatisfactory for its intended purpose. Therefore, the rejection of the claims over Higashiguchi in view of Abrams is hereby withdrawn.

12. Additionally, an obviousness rejection of the claims over Abrams in view of Higashiguchi or any other art is not proper since one would not be motivated to substitute a thermosetting sheet for the combination of binder adhesive and hot melt adhesive of the Abrams invention and/or for the hot melt adhesive layer while also omitting the binder adhesive layer. Therefore, claims 1, 2, 16-18, 25-31, 40-42, 44, 48-50, and 53-57 are allowed, while claim 38 contains allowable subject matter.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER